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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,412	12/14/2001	Naohiro Furukawa	HITA.0132	9775
38327	7590	04/07/2006	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/014,412	FURUKAWA, NAOHIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	FIRMN BACKER	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 28 March 2006.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 10-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 10-22 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28<sup>th</sup>, 2006 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 10-22 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Applicant claims an invention of “determining whether a format of the hardcopy document is available in a database.”

5. Claims 10-22 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

6. Claims 10-22 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynn (U.S. PG Pub No. 2002/0150311) in view of Nitahara (U.S. Patent No. 6,604,108).

9. As per claim 10, 21 and 22 Lynn teaches a document processing system comprising an input unit for reading a storing means on a hardcopy document, a document processing

information extracting unit for extracting encoded document processing information which includes a form or format information of the hardcopy document or at least one hardcopy document handling procedure to be executed in connection with the hardcopy document stored in the storing means; and a document processor for executing document handling procedure wherein the at least one hardcopy document handling procedure includes identifier document and identifying document format (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*). Lynn fails to teach an invention of determining whether a format of hardcopy document is available in a database. However, Nitahara teaches an invention of determining whether a format of hardcopy document is available in a database (*see fig 5, col. 6 line 40 – 7 line 20*). Therefore, it would be obvious to one to ordinary skills in the art at the time the invention was made to modify Lynn's invention to include Nitahara's invention of determining whether a format of hardcopy document is available in a database because this may be virtually organized by means of a database that associates file identifiers with predefined subjects and predefined relational attributes.

10. As per claim 11, Lynn teaches a document wherein the input means includes an image input means for reading a document image (*see abstract fig 1, item 110*).

11. As per claim 12, Lynn teaches a document processing system wherein the document processing means executes the document handling procedure by reading character strings stated on the document in accordance with the document processing information (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

12. As per claim 13, Lynn teaches a document processing system wherein the item is a bill for payment or a commercial paper (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

13. As per claim 14, Lynn teaches a document processing system further comprising: an embedding medium identification means for identifying whether any embedding medium embedded with the document processing information is on the document; and document processing information database retrieving means for retrieving a set of document processing information from a document processing information database of a document provider so as to assign the set of document processing information to the document, if the embedding medium identification means does not identify any embedding medium embedded with the document processing information on the document (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

14. As per claim 15, Lynn teaches a document processing system wherein said database is stored in the document processing system or in a network to which said document processing system is linked (*see abstract fig 1, item 110*).

15. As per claim 16, Lynn teaches a document processing system further comprising a document processing information defining means for defining a new set of document processing information to be applied to the document if the retrieving means can not retrieve any set

document processing information in the database of the document provider (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

16. As per claim 17, Lynn teaches a document processing system wherein the set of document processing information is selected from the database based upon a degree of similarity between a document format associated with the set of document processing information and a document image entered through an image input means (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

17. As per claim 18, Lynn teaches a document processing system wherein the system notifies the document provider the newly-defined set of document processing information so as to be included in the database or to be embedded in other document by the document provider (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

18. As per claim 19, Lynn teaches a document processing system comprising a document processing charge billing means for differentiating charges billed to the document issuer according to whether document processing information is stored on the (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059*).

19. As per claim 20, Lynn teaches a document generating software product, comprising: a communication module for enabling a prospective document user wishing to have a document made to notify a document generator of requirements regarding a desired document layout and a

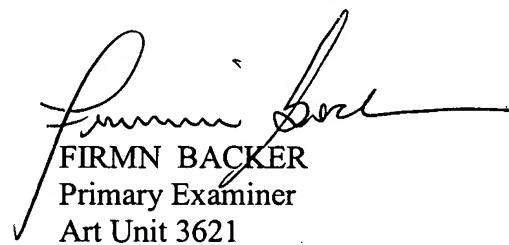
desired document handling procedure; a document layout making module for making a document layout according to the requirements from said prospective document user; a document candidate presenting module for presenting to the prospective document user document candidates made by the document layout making module; a document selecting module for letting the prospective document user select a document out of the document candidates presented by the document candidate presenting module, a document processing information determining module for determining document processing information including a form or format information of the selected document candidate or the desired hardcopy document handling procedure a storing means module for selecting a storing means, encoding the document processing information and for storing the encoded document processing information in the storing means and a document processor for printing on or embedding the storing means on the hardcopy document and for executing the desired hardcopy document handling procedure in connection with the hardcopy document wherein said hardcopy document handling procedure includes identifying document and identifying document format (*see paragraphs 0022, 0023, 0024, 0026, 0027, 0028, 0030, 0046, 0047, 0048, 0059..* Lynn fails to teach an invention of determining whether a format of hardcopy document is available in a database. However, Nitahara teaches an invention of determining whether a format of hardcopy document is available in a database (*see fig 5, col. 6 line 40 – 7 line 20*). Therefore, it would be obvious to one to ordinary skills in the art at the time the invention was made to modify Lynn's invention to include Nitahara's invention of determining whether a format of hardcopy document is available in a database because this may be virtually organized by means of a database that associates file identifiers with predefined subjects and predefined relational attributes.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FIRMN BACKER  
Primary Examiner  
Art Unit 3621

April 4, 2006